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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,333	10/28/2003	Thomas P. Shock	5621.00001	4855
21615	7590	02/09/2006	EXAMINER	
CHRISTOPHER P. MAIORANA, P.C.			LAUX, JESSICA L	
24840 HARPER SUITE 100			ART UNIT	
ST. CLAIR SHORES, MI 48080			PAPER NUMBER	

3635

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/695,333	Applicant(s) SHOCK, THOMAS P.	
	Examiner Jessica Laux	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-12 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/28/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to an apparatus for repairing drywall, classified in class 52, subclass 514.
- II. Claims 13-17, drawn to a method for repairing a hole in a wall, classified in class 52, subclass 742.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case The process as claimed can be practice by another materially different apparatus such as a drywall repair apparatus that has a rectangular end piece that is not semi-rigid.

During a telephone conversation with Mr. Maiorana on January 30, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Claim Objections

Claims 3, 5, and 7 appear to be in error, as they are exact duplicates.

Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regards to claim 12: The specification and drawings do not sufficiently disclose an end section that is an expandable umbrella-type shape.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Condit (4285183).

In regards to claim 1: An apparatus for repairing a hole in a wall comprising: an end section (12) having an area larger than said hole and a cross-section smaller than said hole (Figures 1, 3, 5), wherein said area comprises a continuous piece; a connection section (14) having a first end connected to said end section (Figure 1); and a fastener section (16) connected to a second end of said connection section.

In regards to claim 2: Condit discloses the claimed invention except for specifically disclosing that apparatus is inserted into a slot cut across the hole, wherein the apparatus is inserted without increasing the size of the hole. The examiner would like to point out that the process of "inserting" is a method, or process step is not given much weight in an article claim. See MPEP 2113. Therefore, since Condit discloses the finished product the claimed limitations are met.

In regards to claims 3, 5, and 7: The apparatus according to claim 1, wherein said end section has a disk shape (Col. 2, lines 9-10).

In regards to claim 9: The apparatus according to claim 1, wherein said wall comprises drywall (Col. 1, lines 47-78 and Col. 2, lines 7).

In regards to claim 10: The apparatus according to claim 1, wherein said end section comprises a semi-rigid piece of plastic (Col. 2, lines 12-15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Condit (4285183) in view of Nelson (6508040).

In regards to claim 4: Condit discloses the invention according to claim 1 above, but does not disclose that the connection section comprises a first portion of a tie-wrap or that the fastener section includes a second portion of a tie-wrap, wherein said first and second portions of said tie-wrap form a secure connection. Nelson discloses a drywall repair apparatus having an end section (16) with a connection section (22, Figure 2) where the connection section is any cord-like material (Col. 3, lines 20-21). It would have been obvious to modify the invention as taught by Condit to have a cord-like tie wrap as taught by Nelson as they are readily available and affordable.

Claim 6, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Condit (4285183).

In regards to claim 6: Condit teaches the invention as in claim 1 above, but does not teach the connection section to be an elastic material stretchable over the fastener section. At the time the invention was made, it would have been an obvious matter of design choice because Applicant has not disclosed that the elastic material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Condit's connection section and applicant's claimed elastic connection section would perform the same function of securing the end section.

In regards to claim 11: Condit teaches the invention as in claim 1 above, but does not teach the end section comprising a semi-rigid piece of cardboard. At the time

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the invention was made, it would have been an obvious matter of design choice because Applicant has not disclosed that the semi-rigid cardboard provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Condit's end section and applicant's claimed semi-rigid cardboard would perform the same function of providing a backing for the hole.

In regards to claim 12: Condit teaches the invention as in claim 1 above but does not teach the end section comprising an expandable umbrella-type shape. At the time the invention was made, it would have been an obvious matter of design choice because Applicant has not disclosed that the umbrella-type shape provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Condit's end section and applicant's claimed umbrella-type shape would perform the same function of providing a backing for the hole.

Allowable Subject Matter

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patent No's: 3205904, 3325955, 5983587, 4406107, 2598194, 5058519, 4471594.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JL
01/31/2006


Naecko Slack
Primary Examiner